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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,578	12/11/2003	Adam James Smith	FBT-001	2559
959 7590 07/26/2007 LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			EXAMINER MUSA, ABDELNABI O	
			ART UNIT 2109	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,578

Applicant(s)

SMITH, ADAM JAMES

Examiner

Abdelnabi O. Musa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11 December 2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. The instant application having Application No. 10/735578 has a total of 24 claims pending in the application; there are 3 independent claims and 21 dependent claims, all of which are ready for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Priority

3. As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on applications filed on June 11, 2001 (UNITED KINGDOM 0114177.9)

Information Disclosure Statement

4. As required by **M.P.E.P. 609(C)**, the applicant's submissions of the Information Disclosure Statements dated 12/11/2003 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by **M.P.E.P 609 C (2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, managing instant messaging between user entities must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because the unlabeled rectangular box(es) shown in the drawings (figures 1, 2 and 5) should be provided with descriptive text labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim(s) 1-6, 8-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchiyama et al. Pub. No.: (US-2002/0194264 A1)

As per claim 1, Uchiyama et al teaches a system for playing audio and/or video tracks in a public place in response to requests made by people, (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) in which a jukebox is situated in the public place, the jukebox providing a plurality of audio and/or video tracks from which a selection of tracks to be played in the public place can be made by people in the public place (jukebox provide a plurality of audio and video to the general public [0027]), the jukebox being adapted to register requests for tracks to be played and to store requests whilst other requested tracks are played (a user would be able to request songs digitally [0012]; [0014]; [0017]; [0027]), characterised in that the jukebox registers a request in response to information transmitted by a person using a mobile communications device which is adapted to transmit text, data or speech over a

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wireless communications network (a user can request music and videos using a telecommunication device and a wireless connection [0012]; [0016]; [0027]; [0029]; FIG. 6), the transmitted information being processed automatically to provide data instructions which register the request (the system is automatically registers and responds to the owner of the telecommunication device, [Abstract]; [0054]; FIG. 2).

As per claim 2, Uchiyama et al teaches a system as claimed in claim 1 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), wherein the wireless communications network is a mobile telephone network (a mobile telephone network is used for communication [Abstract]; [0007]; [0027]; [0038]; FIGs. 3-5).

As per claim 3, Uchiyama et al teaches a system as claimed in claim 2 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), wherein the information transmitted is in the form of a text message comprising an identification code for a track (the user makes a music selection using the numbers or letters on the keypad that correspond to the desired music through an operation created with the keypad [0029]; [0032]; FIGs. 3-5).

As per claim 4, Uchiyama et al teaches a system as claimed in claim 3 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), wherein the text message is scanned automatically to identify the identification code for a track and the identified

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code is automatically authenticated (songs are identified by their bar codes for the user to be selected and displayed [0041]; [0049]; [0050]; [0052]; [0056]).

As per claim 5, Uchiyama et al teaches a system as claimed in claim 3 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), wherein the information transmitted further comprises an associated message (additional information is transmitted with from the central server to the user in response to his request [0030]; [0045]; [0054]; FIG. 8).

As per claim 6, Uchiyama et al teaches a system as claimed in claim 5 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) including at least one display unit for displaying to people in the public place a message which is associated with a requested track (the system includes a digital display device that is installed in a location that is open to the public such as a bar, coffee shop, restaurant or other commercial establishments [0027]; [0032]).

As per claim 8, Uchiyama et al teaches a system as claimed in claim 1 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), wherein when a request is received, a confirmation message is provided for the person making the request (a confirmation is send to the user once the request is achieved [0054]; [0056]; [0058]).

As per claim 9, Uchiyama et al teaches a system as claimed in claim 8 (a system for displaying remotely digital contents such as music and video data using a

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telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) wherein the confirmation message is displayed on a display unit for people in the public place (a system for displaying digital contents [Abstract]; [0004]; [0010]; FIG. 1; the system includes a display device that is open to the public to view [Abstract]; [0027]).

As per claim 10, Uchiyama et al teaches a system as claimed in claim 8 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) wherein the confirmation message is transmitted over the wireless communications network (a user can request music and videos using a telecommunication device and a wireless connection [0012]; [0016]; [0027]; [0029]; FIG. 6).

As per claim 11, Uchiyama et al teaches a system as claimed in claim 10 (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) wherein the confirmation message is transmitted as a text message over a mobile telephone network (a mobile telephone network is used for communication between user and provider [Abstract]; [0007]; [0027]; [0038]; FIGs. 3-5).

Regarding claims 12-22 are related to the same limitation set for hereinabove, where the difference used is the phrase 'system' is used hereinabove in the treated claims. The citations from the prior art has been inserted where's necessary in the claims. However, in claims 12-22 only the wordings of the claims were interchanged within the claim itself and this change does not effect the limitation of the above treated claims. The claim's limitations mentioned in the independent claims are repeated in

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many dependent claims throughout the application. Even though claims 12-22 have been differently written from the above treated claims, yet the limitations did not change. As mentioned, claim 12 is the same as claim 1 whereas claim 13 is the same as claim 2, claim 14 is the same as claim 3, claim 15 is the same as claim 4, claim 16 is the same as claim 5, claim 17 is the same as claim 6, claim 18 is the same as claim 7, claim 19 is the same as claim 8, claim 20 is the same as claim 9, claim 21 is the same as claim 10, claim 22 is the same as claim 11.

Regarding claims 23 and 24 wherein claim 23 the applicant claimed a system for supplying a product or services to a user from a provider wherein the user has a portable communication device for communication. Furthermore, the applicant explains in claim 24 that the system is an audio and/or video device to played to the user in a public place by a jukebox. There is no difference between claims 23, 24 and claims 1-11 where hereinabove the claims have the same exact limitations and have been further treated. The Interchanging of wording in claims 23 and 24 did not change the limitation of claims 1-11. The citations from the prior art has been inserted where's necessary in the claims. Refer to the above treated claims for more details.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al. Pub. No.: (US-2002/0194264 A1) as applied to claim 1 above, and further in view of Newnam et al Pub. No.: (US-2002/0133562 A1)

Regarding claims 7, Uchiyama et al. teaches all of the claimed limitation and further teaches a ordering songs according to their type and further teaches a description of ordering and request information processing but does not teach filtering the information for offensive language. However, Newnam teaches filtering items and filter certain language, such as potentially offensive language (refer to [0031]).

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Newnam. Because one must use a filter when processing information especially when such information received over a wireless communication. A filter is used to sort data to transmit clean messages to the server to be complied according to requests. One of ordinary skill in the art would have been motivated to make this modification because Newnam further provides other futures to enhance clean messages.

Conclusion

The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **MPEP 707.05(c)**.

The following are analogous art because they are from the same field of endeavor requesting services and information remotely:

- Bountour et al. Pub. No.: (US-20070094698 A1)
- Knowles Patent No.: (US-5481509)
- Atkinson Pub. No.: (US- 20010053996 A1)
- Gold et al. Pub. No.: (US- 20020032752 A1)

The examiner requests, in response to this Office action, support should be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdelnabi O. Musa whose telephone number is 571-2701901. The examiner can normally be reached on Monday Thru Friday: 7:30am to 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on 571-2726798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.M


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TC 2100